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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/081,707 05/19/98 ISAACS

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EXAMINER

HUFF, S

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

04/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/081,707

Applicant(s)

Isaacs et al

Examiner

Sheela J. Huff

Group Art Unit

1642



☒ Responsive to communication(s) filed on Mar 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 3-79 is/are pending in the application.

Of the above, claim(s) 18-77 is/are withdrawn from consideration.

☒ Claim(s) 1, 3-17, and 78 is/are allowed.

☒ Claim(s) 79 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

DETAILED ACTION

Response to Amendment

1.The amendment filed on 3/6/00 has been considered. Applicant's arguments are deemed to be persuasive.

Claims 1, 3-79 are pending.

Claims 18-77 are withdrawn from consideration as being drawn to a non-elected invention. Applicant is reminded that the non-elected claims need to be cancelled prior to allowance.

2.All of the rejections are withdrawn in view of applicant's amendments/arguments.

3.Newly added claims 18-19 have been renumbered to claims 78-79 are per 37 CFR 1.126.

Claim Rejections - 35 USC § 112

4. Claim 79 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION.

Applicant states that the support for a peptide toxin, a protein or an antibody attached to X1 can be found on page 7, lines 14+. This passage only states that a

Art Unit: 1642

variety of different group can linked to the carboxy terminus. The passage does not specify which groups. Thus, the specification does not provide support for peptide toxin, a protein or an antibody attached to X1.

5. Claim 79 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what applicant means by "protein"--is this meant to read on any protein or only certain proteins with certain functions?

Allowable Subject Matter

6. Claims 1, 3-17 and 78 are allowed.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1642

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703) 305-7866. The Examiner can normally be reached on Monday and Wednesday from 6:30am to 12:30pm and Thursday from 6:30am to 3:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tony Caputa, can be reached on (703)308-3995.

The FAX phone number for the group is (703)308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [anthony.caputa@uspto.gov].

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0196.

Sheela J. Huff
April 10, 2000


Sheela J. Huff
Primary Examiner